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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,534	08/03/2001	Richard B. Himmelstein	4159-4003US2	6981

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Walter G. Hanchuk  
Morgan & Finnegan, LLP  
345 Park Avenue  
New York, NY 10154

EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,534

Applicant(s)

HIMMELSTEIN, RICHARD B.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 28-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

This is in response to an amendment file on October 15<sup>th</sup>, 2003 for letter for patent filed on August 3<sup>rd</sup>, 2001 in which claims 1-27 were presented for examination. In the amendment, claims 1-25 have been amended, claims 26 and 27 have been canceled, and claims 28-32 have been added. Claims 1-25 and 28-32 are pending in the letter.

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-25 and 28-32 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-25 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minton (U.S. PG Pub 2002/0091611 A1) in view of Nieboer et al (U.S. Patent No. 6,418,419).
4. As per claims 1, 14, 15, 17 and 31, Minton teaches a system for implementing barter between a plurality of parties each having one or more security available for barter (*data processing system (20) for allowing individual to buy and sell securities*) (see fig 1, 2, 3, page

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*paragraph 0014*) comprising means (*server, 316*) for creating a barter order (*buys and sell orders*) (*fig 3, page 4 paragraph 0053*) including means for designating a selected quantity (*quantity*) of a (*securities*) to be bartered (*to be traded*) (*fig 3, page 4 paragraph 0053*), means for posting (*displaying order*) barter orders (*order to buy and sell*) via the internet (*public network*) at least one matching barter order (*see figs 1, 3 page 4 paragraph 0055, 0056*), and means for selecting (*matching and executing*) a posted barter order to effectuate the transaction (*paragraph 0057, 0069*). Minton fails to teach means for designating a second class of items to be purchased in a transaction including the sale of the first security, the second security different that the first means for designating a financial value associated with the transaction. However, Nieboer et al teach means for designating a second class of items to be purchased in a transaction including the sale of the first security, the second security different that the first means for designating a financial value associated with the transaction (*see fig 5, column 6 lines 24-40, 8 lines 28-52, 15 lines 52-64*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Minton's inventive concept to include Nieboer et al's concept of means for designating a second class of items to be purchased in a transaction including the sale of the first security, the second security different that the first means for designating a financial value associated with the transaction because this would have improved the efficiency of the barter transact conditional buy and sell orders for security of commerce in real time thereby reduce transaction cost to the traders.

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5. As per claim 2, Minton teaches a system wherein the means designating a financial value comprises means for designating a sale price of the first security and the purchase price for second security (*see fig 4, paragraph 0053, 0062*).

6. As per claim 3, Minton teaches a system wherein the barter value means for designating a financial value included means for designating the sale of the first security and the purchase of the second security each respective market value (*see fig 4, paragraph 0053, 0062*).

7. As per claim 4, Minton teaches a system wherein the means designating a financial value further include means for designating a net financial value for the transaction (*see fig 4*).

8. As per claim 5, Minton teaches a system wherein the means for displaying displays matching barter orders based on the designated date range (*see fig 4*).

9. As per claim 6, Minton teaches a system wherein the means for creating a bartering order further includes means for designating applicable dividend reinvestment preferences for the first class and second security and the means for displaying displays barter orders having dividend reinvestment preferences (*see fig 4, paragraph 0053, 0062*).

10. As per claim 7, Minton teaches a system wherein the means for designating a financial value comprises designating the financial value realized from executing the transaction with the selected matching barter order (*see figs 4, 6, 7*).

11. As per claim 8, Minton teaches a system wherein the means for creating a new barter order further includes means for accessing records related to current market value of the first security and the second security (*see fig 5*).

12. As per claim 9, Minton teaches a system wherein the means for displaying displays a plurality matching barter orders arranged by the net financial value of the transaction (*see fig 4, paragraph 0062*).

13. As per claim 10, Minton teaches a system wherein the first and second securities are selected from a group of comprising stock, stock options, specified rights in stocks, notes, certificate of deposit, bonds and barter dollars (*see fig 4, paragraph 0004*).

14. As per claim 11, Minton teaches a system wherein the item classes are limited to stock (*see fig 4, paragraph 0007*).

15. As per claim 12, Minton teaches a system further comprising means for tracking transactions for reporting taxable events (*see fig 4*).

16. As per claim 13, Minton teaches a system further comprises means for concluding a transaction based on the new barterer's order and a selected matching barter order, identifying

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residual amounts reflective of value disparity between the new and matching orders of the transaction, and designating a recipient of the residual amounts (*see fig 4*).

17. As per claim 16, Minton teaches a method wherein creating a new barter order includes designating a date range for transferring title of the selected quantity of the first class of items to be bartered whereby may elect to defer the transfer of title to the first security to a time after the transaction or elect to transfer title along with the completion of the transaction (*see abstract, page 2 paragraph 0016, claim 16*).

18. As per claim 18, Minton teaches a system wherein the financial value included a sale of the first security and a purchase value of the second security and further including means for calculating and displaying a value ratio based on the sale value of the first security and the purchase value of the second security (*see fig 4, paragraph 0062*).

19. As per claim 19, Minton teaches a system wherein the value ratio is calculated based upon a combination of the ratios  $x/y$  and  $a/b$  where:  $a$  = the barter value of the first class of items to be bartered,  $b$  = a market price of the first security to be bartered,  $x$  = the barter value of the second class of items to be acquired and  $y$  = a market price of the second security to be acquired (*see fig 4, paragraph 0062*).

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20. As per claim 20, Minton teaches a system further comprising means for selecting a desired formula from among a plurality of formulas to calculate the value ratio (*see fig 4, paragraph 0062*).

21. As per claim 24, Minton teaches a system where the means for creating a barter order further includes means for designating a quantity and a barter value of the second class of items such that factional values of the quantities of the first security and the second (*see fig 4, paragraph 0053, 0062*).

22. As per claim 25, Minton teaches a system where the means for creating a barter order further includes means for designating a factional values of the quantities of the first security and the second security (*see fig 4, paragraph 0053, 0062*).

23. As per claim 28 and 32, Minton teaches a system wherein the financial value comprises one of the group including a sale price of the first security and a purchase price of the second security, a net price for the transaction including the sale of the first security and the purchase of the second security an indication to sell the first security at the market price and purchase the second security at market price and the financial value realized from executing the transaction with a selected matching barter order.

24. As per claim 29, Minton teaches a system wherein the matching barter order included the first security to be purchase and the second security to be sold.



25. As per claim 30, Minton teaches a system wherein the matching barter order further include intermediate barter orders including at least one of the first security and second security.

*Allowable Subject Matter*

26. Claims 21-23 are objected to as being dependent upon a rejected base claim, but would be allowable if the provisional double patenting rejection is overcome and if the claims are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

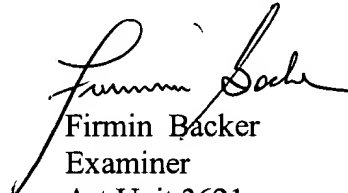
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Firmin Backer  
Examiner  
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December 5, 2003